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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,661	11/10/2003	Dale F. McIntyre	87231F-P	6147

7590 02/07/2008  
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EXAMINER
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TRAN, MYLINH T

ART UNIT	PAPER NUMBER
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2179

MAIL DATE	DELIVERY MODE
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02/07/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/705,661

Applicant(s)

MCINTYRE, DALE F.

Examiner

Mylinh Tran

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 08/16/07 has been entered.

Applicant's request for reconsideration filed 08/16/07 has been entered.

However, arguments regarding rejections under 35.U.S.C 103 to claims (1-49) have not been found to be patentable over newly discovered prior art, therefore, claims 1-49 are rejected under the new ground of rejection as set forth below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schowtka et al. [US. 2005/0010868] in view of Warwick [US. 2002/0082918].

**As to claims 1, 11, 21, 31 and 38,** Schowtka et al. teach a computer implemented method and corresponding apparatus for providing a customized image product to a user comprising the steps/means for obtaining a computer readable media having a software program such that when said computer readable media is placed in a user computer said software will cause said user computer to perform a predefined series of steps used to create said customized image product from a template (page 2, 0022), said computer readable media provides for accessing digital image content (page 2, 0023); loading said computer readable media in said user computer and thereby causing activation of said software, said software automatically allowing use of said digital image content (page 2, 0022-0024), said user composing said customized image product (page 3, 0026); and a unique identifier. (page 5, 0050), said user ordering said customized image product wherein said unique identifier is used to identify said credit and said template (page 5, 0049-0050). Schowtka et al. fail to clearly teach a credit toward the cost of said customized image product. However, Warwick teaches the feature at page 1, 0008. It would have been obvious to one of skill in the art, at the time the invention was made, to combine the Warwick's implementations with the teachings of Schowtka. Motivation of the combination would have been a fair practice to promote business.

**As to claims 2, 12, 22 and 41** Schowtka teaches computer readable media comprising a CD, a computer floppy disc (0023).

**As to claims 3, 13, 23 and 42**, Schowtka teaches customized image product comprising one of a book, a post card, a greeting card (0023).

**As to claims 4, 14, 24 and 43**, Schowtka fails to clearly teach credit comprising the full cost of said customized image product. However, Schowtka et al. fail to clearly teach a credit toward the cost of said customized image product.

However, Warwick teaches the feature at page 1, 0008. It would have been obvious to one of skill in the art, at the time the invention was made, to combine the Warwick's implementations with the teachings of Schowtka. Motivation of the combination would have been a fair practice to promote business.

**As to claims 5, 15, 25 and 44**, Schowtka also teaches the template being provided on said computer readable media (0024).

**As to claims 6, 16, 26 and 45**, Schowtka teaches software program providing for communication with a fulfillment provider over a communication network for placement of said order (0027).

**As to claims 7, 10, 17, 20, 27, 30, 46 and 49**, Schowtka teaches unique identifier being used to obtain said digital image content from said fulfillment provider because each of the image product has its own identifier (0049-0050).

**As to claims 8, 18, 28 and 47**, Schowtka also teaches content being provided on computer readable media (0022-0023).

**As to claims 9, 19, 29 and 48**, Schowtka teaches the digital image content being obtained with respect to image(s) that were captured on film and scanned so as to create said digital image content (0025).

**As to claim 32**, Schowtka teaches fulfillment provider comprising a film product (0027).

**As to claim 33**, Schowtka teaches film product comprising undeveloped film that needs to be developed and scanned in order to obtain said digital images (0049-0051).

**As to claim 34**, Schowtka teaches an order form being used to identify a particular type image product from which said customized image product is to be made (0049-0050).

**As to claim 35**, Schowtka teaches order form being used to identify digital image content to be included in said computer readable media (0049-0050).

**As to claim 39**, Schowtka teaches the plurality of images providing by said user on a portable digital memory device (0023).

**As to claim 40**, Schowtka also teaches the plurality of images providing by said user on a digital image capture device (0025).

**As to claim 36**, Schowtka teaches at least one of the identified digital image content being royalty bearing (0027-0029).

**As to claim 37**, Schowtka teaches said plurality of images being provided to said fulfillment provider over a communication network (0049-0051).

### **Response to Arguments**

Applicants arguments with respect to claims 1-49 have been considered but are moot in view of the new ground of rejection.

### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mylinh Tran. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4141.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

571-273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mylinh Tran

Art Unit 2179



**WEILUN LO**  
**SUPERVISORY PATENT EXAMINER**